09/902,964 2829

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Send attached pages to:

Jimmy Nguyen Phone: 703-306-5858

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From: Laurence D. Cutter (28,501)
Telephone: (845)433-1172 Return Fax: (845)432-9601

Comments: Dear Mr. Nguyen: Please consider the arguments presented in the accompanying letter. Thank you.
SERIAL NO.: 09/902,964 (Natekar/Jano et al.)

Re: Self Aligning Wafer Burn-in Probe
Serial Number: 09/902964
Filed: 2001/07/11
Inventors: Notohardjono et al.

Dear Mr. Nguyen:

Not having had the case in front of me when we spoke yesterday, my recollection and the resulting discussion of the case focused on the only figure that I had recalled to mind, namely Figure 5. Unfortunately, this is not the easiest of the figures to follow, a point which is also made in the specification itself. However, I have looked more closely at Figures 4A through 4D and at paragraph 28 of the specification wherein it is stated that: "For values of p between these selected values [referring to the drawings for p = 0.3 mils, p = 0.4 mils, p = 0.5 mils and p = 0.6 mils] linear interpolation provides an acceptable approximation in the p direction." Based on Figures 4A through 4D and the description in the text as to how these figures should be used, I see absolutely nothing which is either vague or indefinite about the claims. These figures provide as clear and unequivocal boundary description for the recited conjointly selected parameters as one will find in any similar art. This is the best and most accurate way of describing the present invention. It would be an arduous and ultimately inexact task to try to convert the drawings to text. Furthermore, as currently standing, the claims define the scope of the invention in a form and format which would be most easily understood by those of ordinary skill in these arts. In fact, they would "hands down" prefer the current format over the textual version you seem to be suggesting.

Attention is directed to the following cases: 27 USPQ2d 1608 (*Ex parte Fressola*, March 11, 1993), 133 USPQ 598 (*Ex parte Squires*, Patent Office Board of Appeals, May 15, 1962) and 97 USPQ 150 (*In re Tanczyn*, CCPA, March 11, 1953). *Ex parte Fressola* includes the following language cited with approval by the Board of Patent Appeals and Interferences: "Incorporation by reference to a specific figure or table of properties...is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim." Clearly, the reference herein to the figures is more concise and is also, indeed, more exacting.

The case of *In re Tanczyn* is even more relevant. In that case, reference to a figure was permitted in his claim 10. That claim limited the manganese content in a stainless steel alloy by reference to "amounts beneath the curve in the accompanying diagram." If that case was one which constituted an exceptional circumstance, the present case is even more exceptional since it involves the recitation of not just one parameter (manganese content) but rather three conjointly selected parameters (p, L and d). I would also not be surprised to find similarly allowed claims in chemical cases involving multiphase compositions and their associated phase diagrams.

If you and/or SPE Cuneo would like to discuss this matter further, I would be most willing to do so. I should be available today from 12:30 PM until 3:00 PM. I should be available tomorrow from about 1:00 PM until 3:30 PM and on Friday from 8:00 AM to 9:00 AM. I am reachable at 845-433-1172.

Sincerely yours,

Lawrence D. Cutter (Reg. No. 28,501)
April 2, 2003